

## **DRAWING AMENDMENTS (Other than Those Requested on Form PTO-948)**

Drawing amendments are provided on separate sheets accompanying this Response.

### **REMARKS**

#### **1. Power of Attorney and Change of Correspondence Address**

The Applicant has transferred power of attorney to the undersigned attorney and firm, and appropriate Power of Attorney and Change of Correspondence Address documents accompany this Response. Kindly address all further correspondence to the new correspondence address designated in these documents.

#### **2. The Amendments and the Support Therefor**

Six claims (2-3, 8-9, and 21-22) have been canceled, one new claim (23) has been added, and claims 1, 4, 6, 7, 10-12, 16, and 18-20 have been amended to leave claims 1, 4-7, 10-12, 14-16, 18-20, and 23 in the application. No new matter has been added by the amendments or new claims, wherein:

- ***Independent claim 1*** has been amended to:
  - Generally clarify the claim and more specifically recite certain features of the invention, in particular the “triggering generation” of an email once the collected data is sufficiently “complete” (see page 4 lines 18-26 of the application, also par. [0024] of corresponding US Publn. 2001/0049723). In this respect, claim 1 has been amended to incorporate features of its dependent claims 2-3 and 21.
  - Diminish potential §112(2) issues. In this respect, note that incorporated claim 2, which recited “a postal code, country specific address locator code, a telephone area code, or a region specific portion of a telephone number” has been simplified to read “a country specific postal address locator code such as a zip code” and “a region specific portion of a telephone number such as a telephone area code” because page 3 lines 4-10 of the application (par. [0013] of corresponding US Publn. 2001/0049723) describe a “postal (zip) code” as being a species of a “country

specific address locator code,” and describe a “telephone area code” as a species of a “region specific portion of a telephone number.” Thus, the amended language is believed to be clearer in that it does not (for example) recite both a “postal code” and a “country specific address locator code” – recitations which might be regarded as reciting overlapping matter. The amended language is believed to be acceptable in view of MPEP 2173.05(d), which allows use of exemplary claim language (“for example,” “such as”) so long as the scope of the claim is clear.

- **Claim 4** is amended to recite that standardized email addresses are created without the need for user submission of information, as noted at page 4 lines 23-27 of the application (par. [0023] of corresponding US Publn. 2001/0049723);
- **Claim 6** is amended to recite the unique numeric indicator of page 6 lines 27-30 of the application (par. [0052] of corresponding US Publn. 2001/0049723);
- **Independent claim 7** has been amended similarly to claim 1, as discussed above, but here features of its dependent claims 8-9 and 22 have been incorporated. See also page 9 lines 7-11 of the application (par. [0025] of corresponding US Publn. 2001/0049723), which discusses a “computer based application” and providing the invention on distributed computer systems such as the Internet.
- **Claim 10** is amended to recite that standardized email addresses are created without the need for user submission of information (as in claim 4, discussed above), and also to conform language to its parent claim 7 and address §112(2) issues;
- **Claim 10** is amended to conform its language to that of its amended parent claim 7;
- **Claim 12** is amended to recite the unique numeric indicator of page 6 lines 27-30 of the application (par. [0052] of corresponding US Publn. 2001/0049723), and also to conform language to its parent claim 7 and address §112(2) issues;
- **Claim 16** is amended to recite the unique numeric indicator of page 6 lines 27-30 of the application (par. [0052] of corresponding US Publn. 2001/0049723);
- **Claims 18-19** are amended to conform their language to that of their amended parent claim 7;

- **Claim 20** is amended to recite the unique numeric indicator of page 6 lines 27-30 of the application (par. [0052] of corresponding US Publn. 2001/0049723), and also to conform language to its parent claim 7 and address §112(2) issues;
- **New independent claim 23** finds support in claims 1 and 7, and also at page 4 lines 12-26 and page 8 lines 13-15 of the application (pars. [0023]-[0024] and [0070] of corresponding US Publn. 2001/0049723).

Further comments regarding new claim 23 are set forth in Section 7 of this Response.

### **3. Section 3 of Office Action: Title**

The title, “System for Constructing Electronic Email Addresses,” appears to concisely and accurately summarize the claimed subject matter and meet all requirements of 37 CFR §1.72, MPEP 606, and related provisions: the claimed matter is indeed a “system for constructing electronic email addresses.” If it is still believed that the title requires amendment, kindly provide a suggestion.

### **4. Section 4 of Office Action: Objections to the Drawings**

The accompanying replacement drawing sheets (which are each labeled “Replacement Sheet” in the top margin) present amended drawings which are believed to address the drawing objections. These drawings illustrate all claimed features in accordance with 37 CFR §1.83(a):

37 CFR 1.83 Content of drawing.

- (a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. *However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).* In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

Since the new drawings illustrate all claimed features in accordance with 37 CFR §1.83(a) and otherwise meet all drawing requirements, kindly withdraw the objections.

**5. Section 5 of the Office Action: Rejection of Claims 1-12, 14-16, and 18-22 Under 35 USC §101**

Kindly withdraw the rejections of independent claim 1 and its dependent claims 2-6, 14-16, and 21, since these claims are directed to functional descriptive material (i.e., data structures and computer programs which impart functionality when employed as a computer component) which is encoded on a computer-readable medium. This matter constitutes statutory subject matter as per MPEP 2106.01, and thus claims 2-6, 14-16, and 21 should be acceptable under 35 USC §101. As MPEP 2106.01 notes:

"[F]unctional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. . . . "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

. . . . When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). . . .

**I. FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES" REPRESENTING DESCRIPTIVE MATERIAL PER SE OR COMPUTER PROGRAMS REPRESENTING COMPUTER LISTINGS PER SE**

. . . . [C]omputer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. *In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.* See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. . . .

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory

manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

.... When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim. See paragraph IV.B.2(a), below.

Also see *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994) and *In re Beauregard*, 35 USPQ2d 1383 (Fed. Cir. 1995). Since the foregoing claims are directed to functional descriptive material encoded on a computer-readable medium, their rejections under 35 USC §101 should be withdrawn.

As for claims 7-12, 18-20 and 22, these have been amended to recite computers configured to accomplish useful functionality, and these claims should therefore be statutory and acceptable under §101 and MPEP 2106.01.

**6. Section 6 of the Office Action: Rejection of Claims 1-12, 14-16 and 18-22 under 35 USC §112(2)**

**6.a. Alleged Incompleteness of Claims for Omitting Essential Steps/Elements**

Kindly reconsider and withdraw these rejections. MPEP 2172.01 authorizes rejections of this nature only when a claim “omits matter *disclosed to be essential to the invention as described in the specification or in other statements of record*,” and/or where a claim “fails to interrelate essential elements of the invention *as defined by applicant(s) in the specification*.” A review of the cases noted in MPEP 2172.01 shows that rejections of this nature are applied where an Applicant’s specification affirmatively and extensively describes certain features as being critical to the invention, and then fails to include these features in the claim. This is not the case here. Rather, Applicant’s claims clearly meet all requirements of 35 U.S.C. 112, second paragraph, as per Federal Circuit precedent. See, e.g., *Carl Zeiss Stiftung v. Renishaw plc*, 20 USPQ2d 1094, 1101 (Fed. Cir. 1991):

It has long been held, and we today reaffirm, that *it is entirely consistent with the claim definiteness requirement of the second paragraph of section 112, to present "subcombination" claims, drawn to only one aspect or combination of elements of an invention that has utility separate and apart from other aspects of the invention. As one of our predecessor courts stated, "it is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter,"* as it is "entirely appropriate, and consistent with §112, to present claims to only [one] aspect." *Bendix Corp. v. United States*, 600 F.2d 1364, 1369, 220 Ct. Cl. 507, 514, 204 USPQ 617, 621 (1979).

Also see *Reiffin v. Microsoft Corp.*, 54 USPQ2d 1915, 1918 (Fed. Cir. 2000):

Section 112 Para.2 instructs the applicant to "distinctly claim [] the subject matter which the applicant regards as his invention." This does not automatically require inclusion in every claim of every element that is part of the device or its operation.

It is standard for applicants to provide claims that vary in scope and in content, including some elements of a novel device or method, and omitting others. See Irving Kayton, 1 Patent Practice (6th ed.) 3.1, 3.3 (1995):

[P]atent practitioners typically draft a series of claims approximating a spectrum of patent protection. . . . The first way in which a claim may be made narrower is by adding a limitation to it in the form of an additional element.

Claiming an invention in this manner does not raise an issue of compliance with Section 112 Para.1. Indeed, the "omitted element test" threatens this venerable practice, which is also summarized in Ernest B. Lipscomb, III, [1919] 3 Lipscomb's Walker on Patents 290-91 (1985):

[A] claim may cover an invention embracing the entire process, machine, manufacture, or composition of matter which is described in the specification, or it may cover such sub-processes or such sub-combinations of the invention as are new, useful and patentable.

See, e.g., *Special Equipment Co. v. Coe*, 324 U.S. 370 (1945) (reversing the rejection of a sub-combination claim directed to the previously claimed invention less one element). *While the specification must of course describe the claimed invention, it is well established that the claims need not include every component that is described in the specification.* See *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 [128 USPQ 354] (1961) (There is "no legally recognizable or protected 'essential' element . . . in a combination patent.").

*When the claim is supported by the patent's disclosure, is adequately distinguished from the prior art, and otherwise meets the statutory requirements of patentability, neither law nor policy requires that the claim contain all the elements described in the specification as part of the new machine or method.*

Also see *Rodime PLC v. Seagate Technology Inc.*, 50 USPQ2d 1429, 1434 (Fed. Cir. 1999) (“A claim need not claim every function of a working device. Rather, a claim may specify improvements in one function without claiming the entire machine with its many functions.”)

In summary, the Federal Circuit has explicitly authorized claims of the type seen here – which are in no way vague, indefinite, or ambiguous – and Applicant’s specification does not in any way emphasize criticality of any of the features that the rejections now request be added to the claims. Since Applicant’s claims are therefore in accordance with Federal Circuit law and MPEP 2172.01, the rejections should be withdrawn.

**6.b. Alleged Incompleteness of Claims for Omitting Essential Steps/Elements**

Kindly reconsider and withdraw these rejections, since the meaning of all claims would be apparent to one of ordinary skill in the art after review of the specification. Further explanation follows.

Regarding the rejections based on use of the terms “standardized” in claims 1-12, 14-16 and 18-22, please see MPEP 2173.05(b), “Relative Terminology”:

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

Here, the specification clearly illustrates that the meaning of “standardized electronic mail addresses” is addresses which are structured in a predictable format; see, for example, the Abstract. It cannot seriously be said that one of ordinary skill would not understand the meaning of “standardized” after the specification is reviewed. Thus, it is submitted that these claims accord with 35 USC §112(2), since an ordinary artisan would comprehend the bounds of the claims when read in light of the specification. As noted by the Court of Appeals for the Federal Circuit in *Miles Laboratories Inc. v. Shandon Inc.*, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993):

The “distinctly claiming” requirement [of 35 USC §112(2)] means that the claims must have a clear and definite meaning when construed in the light of the complete patent document. ... Section 112 thus ensures definiteness of claim language. ... The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. ... If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more.

(Citations omitted.) See also *Howmedica Osteonics Corp. v. Tranquil Prospects Ltd.*, 74 USPQ2d 1680, 1683 (Fed. Cir. 2005) (“[t]he definiteness of a patent claim depends on whether one skilled in the art would understand the bounds of the claim when read in light of the specification”). Here, it is believed that the meaning of claim 1 is clear and definite, both when read in a vacuum and even more so when read in light of the specification. Please note MPEP 2173 *et seq.*, particularly MPEP 2173.02 (“Clarity and Precision”). Consider: after reading the specification, would the claims be rendered *more* or *less* clear if the word “standardized” was simply removed from the claims? If desired, the term could simply be removed from the claims, but consider that this would simply remove meaning from the claims while making them no clearer.

The same is true of the limitation “to provide” in claim 1. It cannot seriously be contended that one of ordinary skill would not understand that where the claims refer to (for example) “instructions operable to provide a personal name code,” this simply means that the instructions generate a personal name code. It is notable that a search of the USPTO’s own patent database illustrates *tens of thousands* of patents having similar “providing” limitations: see, e.g., claim 1 of U.S. Patent 7,249,383 (“providing a master copy of a media product . . .”); claim 1 of U.S. Patent 7,249,382 (“providing a distributor computer with distributor permission data . . .”); claim 11 of U.S. Patent 7,246,062 (“DTMF engine operable to provide a touch tone menu for selection of a requested node. . .”); claim 1 of U.S. Patent 7,245,506 (“voltage plane operable to provide an electrical current” and “ground plane operable to provide a ground”); etc. If the “to provide” limitations in question were in any way indefinite, they certainly would not appear in thousands of prior patents.

The same is true of the limitations “the known location data” in claims 1 and 7. These claims first recite in early clauses that “known location data” is collected, and later recitations then note the use of this same earlier-recited “known location data.” The meaning of these claims is clear and apparent from their face, and it is not understood why it is believed that one of ordinary skill would find these limitations in any way unclear. If these rejections are maintained, kindly explain. MPEP 706.03(d), which is cited in the rejection, is not seen to provide any guidance on these rejections.



The same is true of the limitations “the family name” in claims 2 (3?) and 9, now present in claims 1 and 7. In particular, see MPEP 2173.05(e), “Lack of Antecedent Basis”:

Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006) (holding that “anode gel” provided by implication the antecedent basis for “zinc anode”); *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) (“controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”). Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation “the outer surface of said sphere” would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir. 2001) (holding that recitation of “an ellipse” provided antecedent basis for “an ellipse having a major diameter” because “[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter”).

Here too it cannot seriously be contended that an ordinary reader would not grasp the meaning and scope of “the family name.” Also, note that these claims refer to the personal name code including “at least the family name of the individual”, and their parent claims discuss “a personal name code indicative of the name data of the individual”. Consider that an individual’s name inherently includes a family name, and as noted in MPEP 2173.05(e), inherent components do not require antecedent recitations.

All other 35 USC §112(2) rejections are believed to be addressed by the amendments to the claims.

**7. Sections 7-8 of the Office Action: Rejection of Claims 1-12, 14-16, and 18-22 under 35 USC §103(a) in view of U.S. Patent 5,987,508 to Agraharam et al.**

Before reviewing these rejections in greater detail, it is initially useful to review the teachings of *Agraharam et al.*. *Agraharam* is directed to the problem that email senders often cannot remember a person’s email address (see column 1 lines 10-36, column 2 line 66-column 3 line 9). *Agraharam* seeks to bypass this problem by allowing the use of one’s telephone number as an email address: by creating an “alias email address” which “consists of the recipient’s telephone number

as the recipient name at a well-known and publicized common domain name server” (column 1 lines 44-47). Thus, a recipient may register with the provider of the invention and provide his/her telephone number and “primary” email address (column 3 lines 35-41). The invention then creates an alias email address, e.g., [telephone number]@email.[domain], that senders may use if they do not know the recipient’s primary email address (column 3 lines 41-50). An example given by the patent is that Steve G., whose telephone number is 201-555-8765 and whose email is steveg@attmail.com, might be assigned the alias email 2015558765@email.att.net.

Column 5 lines 8-23 note that when an alias email such as 2015558765@email.att.net is generated, associated alias emails which include country codes may also be generated, such as 2015558765@email.att.us.net, 2015558765@email.att.uk.net, 2015558765@email.att.ca.net, and so forth. This allows a sender to use an alias email which either does or does not include a country code.

Further, column 5 lines 24-37 note that since multiple people may share the same telephone number, multiple recipients may register with the same telephone number (and with different primary email addresses). In this case, so that emails sent to an alias email address are sent to the correct recipient at his/her correct primary email address, a name may be added to the alias email addresses (such as 2015558765.steve@email.att.net) so that the alias email is directed to the desired individual at his/her correct primary email address.

When an email is then sent to an alias email address (e.g., 2015558765@email.att.net), the provider receives it, looks up the primary email address associated with the alias email address (e.g., steveg@attmail.com), and forwards the email on to the recipient’s primary email address (column 3 lines 51-66). Where a recipient has not yet registered for the service and a sender sends an email to the alias email address (e.g., 2015558765@email.att.net), the system will not be able to locate the recipient’s primary email address, and here the provider might generate an automated voice mail and deliver it to the corresponding telephone number (here 201-555-8765) suggesting that the recipient register for the service (column 4 lines 13-41; see also column 5 line 38 onward). If the recipient does not register, the email can be returned to the sender (column 4 lines 28-41).

Also, registered users are allowed to enter the telephone number of an intended recipient, and thereby receive the actual/primary email address of the recipient rather than the alias email (column 6 lines 6-22).

*Independent claims 1 and 7* have been amended to further recite that name and known location data for an individual are collected and used to generate an at least partial entry for the individual in a database. When the collected data includes (1) name data which includes at least the family name of the individual, and (2) location data which includes one or more of a country specific address locator code (e.g., a postal code) and/or a region specific portion of a telephone number (e.g., a telephone area code), the collected data is effectively regarded as “complete” or “sufficient” rather than merely “partial,” and a standardized email address is *then* generated which is indicative of the collected data. Further, the standardized email address includes data indicative of both the collected personal name and the collected location data. Note that in the claimed invention, a database is first built which includes at least partial name and location data for an individual, and the invention then creates an email address (and adds it to the database) only when the name and location data for the individual is complete (i.e., when it includes certain items of name and location data) rather than partial.

*Agraharam* does not disclose the invention of independent claims 1 and 7, nor would one of ordinary skill be led to construct the claimed invention from *Agraharam* alone, or in view of the other references cited in support of the Office Action’s “Official Notice.” In *Agraharam*, an alias email address is created for a recipient *only* once a recipient “opts in” and registers for the *Agraharam* system, requiring that the recipient submit his/her telephone number and actual/primary email address (see *Agraharam* at column 3 lines 35-41). There is no disclosure or suggestion that *Agraharam* begin compiling a “partial entry” database beforehand, nor that *Agraharam* trigger generation of an email address once the “partial entry” is regarded as “complete.” Further, there is no disclosure or suggestion of triggering the email address generation once *Agraharam* has (1) family name *and* (2) one or more of a country specific postal address locator code (e.g., a postal code) *and/or* a region specific portion of a telephone number (e.g., a telephone area code): *Agraharam* plainly does not contemplate anything but an alias email address founded on a complete

telephone number. This alias email address may include an email country code (column 5 lines 8-23), and/or that a first name may be appended to a telephone number where multiple people share the same telephone number (column 5 lines 24-37), but in any event it is clear that *Agraharam* does not contemplate data as being “complete,” and triggering generation of an email address, once no more than (1) family name *and* (2) one or more of a country specific postal address locator code (e.g., a postal code) *and/or* a region specific portion of a telephone number (e.g., a telephone area code) are known. Again, *Agraharam*’s purpose is to enable emailing where a sender knows no more than the recipient’s telephone number, and thus no artisan would start with a system such as *Agraharam* and end with a system such as the one claimed, where the email address need not even include a telephone number.

*Agraharam* also does not disclose or suggest the invention of ***dependent claims 4 and 10***, which recite that the standardized email addresses are automatically created without individuals’ need to provide name and location data. In contrast, *Agraharam* requires that a user *must* register with the provider of the service, including providing his/her actual/primary email address and telephone number (see column 3 lines 35-41), before an alias email address can be generated. An *Agraharam* standardized email cannot be created otherwise, since the user’s actual/primary email address is unknown, or is otherwise not linked to the user’s telephone number. Thus, there is no suggestion that *Agraharam* be modified to automatically collect information and generate standardized email addresses without user participation.

Regarding ***dependent claims 6, 12, 16, and 20***, kindly reconsider and withdraw these rejections. The Office Action alleges that it would be obvious to attach a unique indicator to an *Agraharam* email. However, consider: *Agraharam* seeks to provide a solution to unknown email addresses by allowing senders to send emails to alias addresses based on the recipients’ phone numbers, which the senders do know. *If a unique numeric identifier was added to such alias addresses, senders would not know the numeric identifiers and would not know how to compose the alias addresses, and the invention would not function for its intended purpose.* Further consider that since *Agraharam*’s alias email addresses are based on telephone numbers, all alias email addresses will be unique except where multiple recipients share the same telephone number – and *Agraharam*

addresses this by appending the first names of the recipients, rather than adding any numeric code (see column 5 lines 24-37). A sender would naturally know the first name of the recipient that he/she seeks to email, and thus appending a first name to the *Agraharam* email is not problematic. In contrast, unlike a telephone number or first name for a recipient, a sender would not know any unique numeric identifier assigned to a recipient, and would therefore not be able to readily email a recipient as *Agraharam* intends. Thus, we submit that claims 6, 12, 16, and 20 are novel and unobvious. If it is asserted otherwise, please explain: if a unique numeric identifier was attached to *Agraharam*'s telephone number-based email addresses, how would a sender who seeks to email the recipient, and who knows no more than the recipient's telephone number (and/or the recipient's name), be able to guess the numeric identifier and email the recipient?

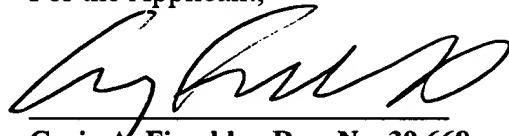
#### **8. New Claim 23**

New claim 23 is submitted to be allowable for at least the same reasons as claims 1 and 7. Again, *Agraharam* does not state or suggest that a standardized electronic mail address is generated once the system collects *both* (1) the family name of the individual, *and* (2) a country specific postal address locator code (such as a zip code), and/or a region specific portion of a telephone number (such as a telephone area code) – *Agraharam* generates an email once a recipient's telephone number and primary email address are known, and there is no suggestion whatsoever that *Agraharam* should use both family name and postal locator code and/or region specific telephone number portion, nor is there any hint about why any of these would be useful. Why would one incorporate these into *Agraharam*? More specifically, when it is considered that *Agraharam* is intended to provide a way for a sender who only knows a recipient's telephone number (and first name) to compose an email address for the recipient, why would one incorporate these features, which would only increase the amount of information that a sender needs to know in order to send an email, and which would also increase the risk of error (in case a sender did not accurately know family name and one or more of zip code and area code)? Further, why would *Agraharam* store partial entries in the index database?

**9. In Closing**

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



**Craig A. Fieschko, Reg. No. 39,668**

DEWITT ROSS & STEVENS S.C.

Excelsior Financial Centre

8000 Excelsior Drive, Suite 401

Madison, Wisconsin 53717-1914

Telephone: (608) 828-0722

Facsimile: (608) 831-2106

cf@dewittross.com

**ATTACHMENTS:**

- Power of Attorney and Change of Correspondence Address
- Revised drawing sheet (FIG. 3)
- PTO-2038 (\$60)